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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|------------------------|-------------|----------------------|---------------------|------------------|
| 09/742,803 | 12/19/2000 | Gary R. McLuen | NEI-00104 | 7285 |
| 28960 | 7590 | 03/29/2005 | EXAMINER | |
| HAVERSTOCK & OWENS LLP | | | HANDY, DWAYNE K | |
| 162 NORTH WOLFE ROAD | | | ART UNIT | |
| SUNNYVALE, CA 94086 | | | PAPER NUMBER | |

1743

DATE MAILED: 03/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/742,803

Applicant(s)

MCLUEN ET AL.

Examiner

Dwayne K Handy

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-30,35-38,40 and 44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27-30,35-38,40 and 44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>1/31/05, 2/14/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 27-30, 35-38, 40, 42 and 44 were previously rejected under 35 U.S.C. 102(b) as being anticipated by McGraw et al. (5,368,823). This rejection remains in effect. Please see Response to Arguments below.

Response to Arguments

3. Applicant's arguments filed 2/22/2005 have been fully considered but they are not persuasive. In traversing the rejection made by the Examiner in the previous action(s) applicant is relying on several arguments including: (1) McGraw does not teach a vial that holds material in the vial above the frit (pages 5-6, paragraphs 4-6); and (2) McGraw does not teach a pressure tight seal between the vial and a cartridge. The Examiner respectfully disagrees.

Applicant has argued that since McGraw contains two frits (9, 9A) having material between them, McGraw does not anticipate the limitation of a vial that retains material above a frit after a flushing procedure. The Examiner notes that applicant has used "comprising" language in claiming the vial. Therefore, the vial of McGraw may

Art Unit: 1743

have more than one frit and still meet the limitation of the claim. This is, in fact, what McGraw shows in Figure 6 – material held above a frit (9) that stays above the frit during multiple synthesis cycles. Therefore, the Examiner believes McGraw meets the limitation of a vial that retains material above a frit after a flushing procedure.

Applicant has also argued that McGraw does not teach a pressure tight seal between the vial and a cartridge. Again, the Examiner points out that applicant has used the language comprising when claiming the vial. Therefore, while the Examiner concedes that a Luer fitting is used to help seal the vial into the “cartridge” (elements 16/17) of McGraw, there is nothing in the claim that excludes the presence of the Luer fitting as well. The vial of McGraw is sized to fit within the Luer fitting that is sized to fit into the bulkhead (16) of McGraw. This provides a pressure tight seal with the exit basin (17). Therefore, the Examiner believes McGraw meets the limitation of a pressure tight seal between the vial and a cartridge.

Conclusion

4. This is an RCE of applicant's earlier Application No. 09/742,803. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 1743

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Frank et al. (US 2003/0211539) and Rosenthal et al. (4,882,127) show reaction systems having reactors containing a frit.


6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dwayne K Handy whose telephone number is (571)-272-1259. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1743

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DKH
March 21, 2005


Jill Warden
Supervisory Patent Examiner
Technology Center 1700